

**Appl. No.** : 09/772,538  
**Filed** : January 29, 2001

### **REMARKS**

The instant application is a continuation in part of Application No 09/744047 filed January 16, 2001 which is the U.S. National Phase application of International Application No PCT/EP99/04951 filed July 13, 1999, which designated the United States. The PCT application, in turn, claims priority under 35 U.S.C. § 119(a)-(d) to German Application No. DE 198 31 758.1, filed July 15, 1998.

#### **Filing under 35 U.S.C. § 365(c)**

The present application was filed in accordance with the provisions of 35 U.S.C. § 365(c) that provide for the filing of a continuation or continuation-in-part application of an international application. 35 U.S.C. § 363 provides that "An international application designating the United States shall have the effect from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent and Trademark Office...".

#### **Amendment of Specification**

The specification has been amended to properly refer to the parent applications in accordance with 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2). Although the application was filed after November 29, 2000, no surcharge under 37 C.F.R. § 1.17(t) is necessary to amend the specification to refer to the parent applications. The present application claims priority under 35 U.S.C. § 365(c) to the prior-filed international application. The reference to the prior-filed application, required by 37 C.F.R. § 1.78(a)(2), was present in the specification when the application was filed. When the application was filed, the specification indicated that the present application was a "continuation in part of U.S. Application No. 09/\*\*\*,\*\*\* which is the U.S. National Phase application under 35 U.S.C. §371 of International Application PCT/EP99/04951, filed July 13, 1999." The application number referred to as "\*\*\*,\*\*\*" was simply the application number assigned by the U.S. Patent and Trademark Office to the International Application, which was properly identified by its international application number and filing date. Accordingly, the reference to the prior filed application under 35 U.S.C. § 365(c) was present within the time limit referred to in 37 C.F.R. § 1.78(a)(2)(ii).

If for some reason, the Patent and Trademark Office concludes that the presentation of the U.S. Application No. assigned to the U.S. national phase of the international application from which priority is claimed after the time period referred to in 37 C.F.R. § 1.78(a)(2) (ii) cannot be

**Appl. No. : 09/772,538**  
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made without the surcharge set forth in 37 C.F.R. § 1.17(t), then please charge that fee to Deposit Account No. 11-1410. In the event the fee is believed necessary by the Patent and Trademark Office, then Applicants also state that the entire delay between the date the claim was due under 37 C.F.R. § 1.78(a)(2)(ii) and the date of the present submission, was unintentional. However, Applicants maintain that such fee and statement are unnecessary in accordance with the foregoing explanation.

### **Conditions for Priority**

In order to file a continuing application in accordance with 35 U.S.C. § 365(c), the statute states that the conditions of 35 U.S.C. § 120 must be met. The condition of 35 U.S.C. § 120 relating to the time of filing requires the later application to be “filed before the patenting or abandonment of or termination of proceedings on the first application...”. 37 C.F.R. § 1.78(a)(1) provides that “a nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or copending international applications designating the United States of America” with the condition that each application must be “an international application entitled to a filing date in accordance with PCT Article 11 and designating the United States of America”. International Application No PCT/EP99/04951 filed July 13, 1999 was pending as of the January 29 2001 filing date of the present application, via the U.S. national phase thereof, Application No 09/744047. Therefore, the claim to priority is proper.

The international application was filed within twelve months of the filing date of the priority application filed in Germany. Thus, the claim to priority to the German application DE 198 31 758.1 by PCT/EP99/04951 under 35 U.S.C. § 119(a)-(d) is proper. The declaration for the instant application specifies the related U.S. application, as well as the prior foreign application filed in Germany. In view of the foregoing, Applicants respectfully request that the objections to the priority claim be withdrawn.

### **Response to Rejection under § 102**

The Preissner reference from the Journal of Molecular Biology was published July 17, 1998, and was authored by the identical individuals who are indicated as inventors in the instant application. Consequently, Applicant contends that the Preissner reference should not serve as prior art under 35 U.S.C. §102(a) as this reference fails to fulfill the “by others” requirement of this section. Additionally, the Preissner reference should not serve as prior art under 35 U.S.C. §102(b)

Appl. No. : 09/772,538  
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as this reference was not "described in a printed publication ... more than one year prior to the data of the application for patent in the United States". Consequently, Applicant contends that this reference does not constitute a valid prior art reference under 35 U.S.C. §102 and cannot be used to support a rejection of the Claims in the instant application. In light of the foregoing priority considerations, Applicant respectfully requests that the Examiner reconsider the rejection.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: \_\_\_\_\_

12/18/2003

By \_\_\_\_\_

Kirk E. Pastorian  
Registration No. 48,756  
Agent of Record  
Customer No. 20,995  
(909) 781-9231

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